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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/764,110	12/06/1996	YUHPYNG L. CHEN		4202

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New York, NY 10023

EXAMINER

BERCH, MARK L

ART UNIT	PAPER NUMBER
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1624

37

DATE MAILED: 03/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

08/764,110

Applicant(s)

CHEN, YUHPYNG L.

Examiner

Mark L. Berch

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-4,8-10,12-14,18 and 25 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 2-4,8-10,12-14,18 and 25 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

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DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 11-21-2003 has been entered.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 2, 4, 8-10, 12-14, 18, 25 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The inclusion of R^4 as CF_3 is new matter for reasons set forth in considerable detail, and it is clear that an impasse has been reached. Applicants are entitled to only what they have set forth in their specification, and no more. Everything is given its ordinary meaning unless the specification specifically defines it otherwise. The main definition (Seen at page 4, lines 10-18) simply does not provide R^4 as CF_3 , and so applicants cannot now claim this. The main definition is taken exactly as it is written,

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nothing more and nothing less. Applicants have pointed to the page 9 text. It too is taken for exactly what it says, no more and no less. That is, it only says what it says; it does not say anything beyond that. This essentially describes a small genus where R^3 has four values, R^4 has three (including the CF_3), etc. Applicants are certainly entitled to claim that. But applicants are not entitled to claim material that falls into neither the main formula material nor the page 9 material. Thus for example, that subgenus of compounds which have R^4 as CF_3 , and R^3 as e.g. CN is not embraced by either set of disclosures and hence cannot be claimed.

With regard to understanding the page 9 material, Applicants had asked, "since when does a semicolon necessarily mean "and"?" When used in a list, the comma and the semicolon are normally understood as "and". They would never be understood as "or" without a specific direction to do so, and as applicants have admitted in their recent remarks, there is no such direction to do so. Further, this particular list defines a different variable in each segment, making it clear that this is a genus in which the variables are being defined in sequence. The exact same format is used in the main definition on pages 2-5. Each variable choice is separated by a semicolon (see e.g. page 2, lines 25, 27, 31, etc.), with the understanding that the genus is such that it has this definition for A and this definition for B and this definition for D, etc. Page 9 would be read in the same way, a genus in which it has this definition for R^3 and that definition for R^4 , etc. Applicants note that the list is incomplete, in that elements A and B are not defined. One of ordinary skill in the art would then have to use the main definitions by default; there is no need to need to repeat the same definitions.

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Applicants in their remarks refer to “an obvious discrepancy which requires a sensible resolution.” The examiner does not agree that there is any discrepancy. Different embodiments of different scope appear at different places in the specification. There is nothing out of the ordinary with that. Applicants can claim one, or the other, or both. But applicants cannot claim that which falls into neither category, which is exactly what applicants now seek to do.

Accordingly, this is held to be new matter. Similarly, the introduction of R^4 as CF_3 on page 4, line 11 is likewise objected to as new matter and must be removed.

Claims 3, 4, 8-10, 12-14, 18, 25 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The new wording for the rings is unclear. It begins by setting forth two such rings, $-NR^1R^2$, and $-CR^1R^2R^3$. After setting for the ring size and the option double bonds to be present, it says: “that in the case where said ring is $-CR^1R^2R^3$ it is carbocyclic, subject to the proviso that when said ring has from 5 to 8 members” that 1-2 C atoms can be replaced by O or S or NZ3. This is unclear because it can be read in very different ways:

A. The first piece, the “that in the case where said ring is $-CR^1R^2R^3$ it is carbocyclic,” is taken literally as written, and says that the $-CR^1R^2R^3$ ring must be carbocyclic. Thus, that ring, but not the other, is limited. Therefore, the rest, which talks about non-carbocyclic rings, must be talking only about the NR^1R^2 ring. In this view, a comma is missing before the first “it”. The “said ring” has no antecedent.

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B. In the first piece, the word "it" does not belong, and thus the text describes only the initial state of the ring. The text is thus saying that if the $-CR^1R^2R^3$ ring is carbocyclic, then e.g. S-for-C substitution could occur, but if it were not, if it were, say, a P containing ring, then S-for-C-substitution could not occur. But note that since there was never any limitation on the nature of the ring atoms to begin with, it is not clear why the replacement feature is there at all. Any ring formed after the atom replacement would have been the initial ring.

To deal with this, since these two rings $-NR^1R^2$ and $-CR^1R^2R^3$ have different definitions, it is suggested that applicants write two separate definitions, one for each ring. Each definition should completely define the original ring, plus any permitted modifications of the ring. And applicants should make sure that the modifications are not already included in the original definition. Applicants may wish to place the word "carbocyclic" directly before the first appearance of the term $-CR^1R^2R^3$, so that it is clear that this ring begins as a carbocyclic one.

Claims 3, 4, 8-10, 12-14, 18, 25 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Because of the ambiguities in the word meaning, point 1 of the previous Final Rejection remains. Fixing the indefiniteness rejection will presumably take care of this point 2. Any inquiry concerning this communication or earlier communications from the examiner should be

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directed to Mark L. Berch whose telephone number is 571-272-0663. The examiner can normally be reached on M-F 7:15 - 3:45.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mukund Shah can be reached on (571)272-0674. If you are unable to reach Dr. Shah within a 24 hour period, please contact James O. Wilson, Acting-SPE of 1624 at 571-272-0661. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Mark L. Berch
Primary Examiner
Art Unit 1624

3/8/04